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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,239	01/20/2000	Norikane Nabata	Q57646	2929

7590 02/24/2005

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EXAMINER
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VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/487,239

Applicant(s)

NABATA ET AL.

Examiner

Hai Vo

Art Unit

1771

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 6 and 8-12.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because: of the following reasons. Applicants argue that one of ordinary skill in the art would not be motivated to substitute the porous high molecular weight polyolefin of Takiguchi for the expanded polyethylene film of Dauber as the examiner asserts because (1) the filter in the Takiguchi invention does not hold an absorbent layer and is therefore a different type of filter from that disclosed in Dauber and (2) Takaguchi suggests a filter comprising a multilayer structure in which both layers are formed of the same type of material. The arguments are not found persuasive for patentability. Takiguchi does not need to disclose the filter that holds an absorbent material because such is already taught in the primary reference (Dauber reference). Both Dauber and Takaguchi inventions are related to the filter technology and therefore the combination of the teachings of the two references is proper and sufficient to establish the prima facie case of obviousness. It is agreed that Takiguchi discloses the two layers are preferably made from the same type of material. However, Takiguchi is a secondary reference, not a primary reference used in the art rejections, therefore, substitution the porous film of high molecular weight polyolefin as taught by Takiguchi for the porous polyethylene film of Dauber does not destroy any properties necessary for the utility of Dauber's product. The substitution instead provides the filter of Dauber with higher mechanical strength, which is important to the expectation of successfully practicing the invention of Dauber, thus suggesting the modification. Applicants further argue that the present invention provides unexpected and superior results over the conventional porous film of the comparative example 1 in terms of the collection efficiency and pressure drop. The arguments are not commensurate in scope with the claims since nothing specific about the collection efficiency and pressure drop has been incorporated in the claims. Further, it is recognized that the conventional porous film of the comparative example 1 is made from a PTFE which is structurally different from the filter of Dauber which comprises a porous layer PTFE and a porous polyethylene film layer. The examiner suggests that two conditions must be met to place the instant claims in condition for allowance. First, the novel properties such as collection efficiency, pressure drop or moisture permeability must be incorporated in the claims. Second, Applicants should provide the evidence or affidavit to show that the filter of Dauber fails to meet the novel properties.

Hai Vo

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